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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,302	12/04/2000	David R. Hansen	MBHB00-787	7605

1333 7590 02/18/2005

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EXAMINER

THOMPSON, JAMES A

ART UNIT PAPER NUMBER

2624

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,302

Applicant(s)

HANSEN, DAVID R.

Examiner

James A Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Arguments

1. Examiner notes that claim 1-39 have been cancelled, thus rendering the rejections to claims 1-39 moot. The rejections based on the prior art of claims 40-63, which have been added by amendment, are discussed below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 40, 42-43, 46, 48-50, 52, 54-55, 58 and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Hanson (US Patent 5,956,736).

Regarding claims 40 and 52: Motoyama discloses a system (figure 2 and column 3, lines 26-31 of Motoyama) for printing a document having a plurality of pages (column 5, lines 28-35 of Motoyama) comprising a print document management system (PDMS) program for running on a computer (column 5, lines 50-52 of Motoyama), the PDMS program facilitating receiving the document into the print document management program (column 5, lines 46-52 of Motoyama). The various software modules (figure 3(200-210) of Motoyama) constitute a print document management system

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and receive the document to be processed (column 5, lines 46-52 of Motoyama).

Motoyama further discloses assigning group identifiers into the document to establish groups of pages in the document (figure 1a(110) and column 3, lines 49-54 of Motoyama); and instructing the computer to send one or more of the groups of pages of the document (column 10, lines 34-40 of Motoyama) to an output data stream for printing (column 11, lines 38-43 of Motoyama).

Motoyama further discloses a program executed by a host computer, and therefore a corresponding graphical user interface (GUI), for altering the document data (column 5, lines 38-42 of Motoyama).

Motoyama does not disclose expressly a GUI that facilitates the steps of receiving, assigning and instructing; and that performing said step of assigning thereby creates an amended document.

Hanson discloses a GUI (figure 6C and column 8, lines 44-47 of Hanson) that is used to open, and thus receive, document data (column 10, lines 30-32 of Hanson); assign identifiers in the document (column 11, lines 48-54 of Hanson), and therefore create an amended document (column 11, lines 43-48 of Hanson); and instruct the computer to output the document data (column 13, lines 60-64 of Hanson).

Motoyama and Hanson are combinable because they are from the same field of endeavor, namely digital document data processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to perform the steps of receiving, assigning and instructing, as taught by Motoyama, using a GUI and thus creating an amended document, as

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taught by Hanson. The motivation for doing so would have been to allow a user to modify the contents of the document and the manner in which said document is printed (column 4, lines 34-39 of Hanson). Therefore, it would have been obvious to combine Hanson with Motoyama to obtain the invention as specified in claims 40 and 52.

Further regarding claim 40: The system of claim 52 performs the method of claim 40.

Regarding claims 42 and 54: Motoyama discloses that the print operator instructs the computer to send some or all of the document (column 10, lines 34-40 of Motoyama) to one or more printing devices (column 11, lines 38-43 of Motoyama).

Regarding claims 43 and 55: Motoyama discloses that a printing device processes the amended document that it receives from the computer (column 11, lines 38-41 of Motoyama) and prints one or more pages of the amended document (column 11, lines 41-43 of Motoyama).

Further regarding claims 46 and 58: Hanson discloses that the PDMS receives the input identifiers through the GUI (figure 6C(610) and column 11, lines 27-30 of Hanson) by prompting the printer operator to select group identifiers from a list of identifiers (figure 6C(620) and column 11, lines 42-44 of Hanson).

Further regarding claims 48 and 60: Hanson discloses that the assignment of group identifiers (column 6, lines 59-64 of Hanson) is made by entering an address or other label (figure 6C(610) and column 11, lines 27-30 and lines 42-44 of Hanson) that instructs the computer to format the groups for compatibility with input requirements of a printing device (column 13, lines 52-55 and column 14, lines 6-10 of Hanson).

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The document is saved as an object instead of as raw data (column 13, lines 52-55 of Hanson), said object formatted based on the various identifiers input by the operator for the various portions of said document (figure 6C(610) and column 11, lines 27-30 and lines 42-44 of Hanson). The document is then output based on the definitions given in the object data at the specific output device from which the document is to be output (column 14, lines 6-10 of Hanson), thus formatting the document group for compatibility with input requirements of the printing device.

Regarding claims 49 and 61: Motoyama discloses defining a plurality of page sets (figure 1A(104) of Motoyama) from the overall document body (figure 1A(102) of Motoyama) based on page set definitions (column 4, lines 13-23 of Motoyama). Therefore, if the selected pages of a first page set overlap the selected pages of a second page set, then at least one page of the document will belong to more than one group of pages.

Further regarding claims 50 and 62: Hanson discloses that the identifiers define the content of the portions of the document (column 12, lines 1-6 of Hanson). Therefore, if a group of document pages do not have an identifier, then said group of document pages is a null page group.

4. Claims 41, 44, 47, 53, 56 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Hanson (US Patent 5,956,736) and Rourke (US Patent 5,995,721).

Regarding claims 41 and 53: Motoyama discloses printing multiple groups of pages (column 10, lines 34-40 of Motoyama).

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Motoyama in view of Hanson does not disclose expressly that said print operator instructs the computer to send multiple groups of pages simultaneously.

Rourke discloses a print operator instructing a computer to send multiple groups of pages simultaneously (figure 6; column 8, lines 16-19; and column 9, lines 18-23 of Rourke).

Motoyama in view of Hanson is combinable with Rourke because they are from the same field of endeavor, namely digital document data processing and printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the user to select a printer from a plurality of printers for each group of pages to be printed, thus sending multiple groups of pages simultaneously, as taught by Rourke. The motivation for doing so would have been to print each group of pages based on the attributes of said group of pages, since each printer prints different types of print data differently (column 10, lines 19-26 of Rourke). Therefore, it would have been obvious to combine Rourke with Motoyama in view of Hanson to obtain the invention as specified in claims 41 and 53.

Regarding claim 44 and 56: Motoyama discloses printing multiple groups of pages (column 10, lines 34-40 of Motoyama).

Motoyama does not disclose expressly that said print operator may select multiple groups of pages simultaneously for printing by inputting the identifiers for respective page groups to the computer.

Hanson discloses a print operator inputting the identifiers for respective page groups to the computer (column 11, lines 43-48 of Hanson) and printing the document based on the various inputted identifiers (column 13, lines 60-64 of Hanson).

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Motoyama and Hanson are combinable because they are from the same field of endeavor, namely digital document data processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have an operator enter identifiers for document portions, as taught by Hanson, said document portions being the different groups of pages taught by Motoyama. The motivation for doing so would have been to allow an operator to output document data specifically in the format that the operator desires (column 14, lines 4-10 of Hanson). Therefore, it would have been obvious to combine Hanson with Motoyama.

Motoyama in view of Hanson does not disclose expressly that said print operator may select multiple groups of pages simultaneously for printing by inputting the identifiers for respective page groups to the computer.

Rourke discloses a print operator may select multiple groups of pages simultaneously for printing (figure 6; column 8, lines 16-19; and column 9, lines 18-23 of Rourke).

Motoyama in view of Hanson is combinable with Rourke because they are from the same field of endeavor, namely digital document data processing and printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the user to select a printer from a plurality of printers for each group of pages to be printed, thus sending multiple groups of pages simultaneously, as taught by Rourke, based on the identifiers that have been inputted by the operator, as taught by Hanson. The motivation for doing so would have been to print each group of pages based on the attributes of said group of pages, since each printer prints different types of print data differently (column 10, lines 19-

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26 of Rourke). Therefore, it would have been obvious to combine Rourke with Motoyama in view of Hanson to obtain the invention as specified in claims 44 and 56.

Regarding claims 47 and 59: Motoyama in view of Hanson does not disclose expressly that the PDMS prompts the printer operator to associate each identifier with a printing device.

Rourke discloses prompting a printer operator to associate each identifier with a printing device (figure 6 and column 8, lines 16-25 of Rourke).

Motoyama in view of Hanson is combinable with Rourke because they are from the same field of endeavor, namely digital document data processing and printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to map user selected document property identifiers to printers based on printer properties, as taught by Rourke. The motivation for doing so would have been print each group of pages based on the attributes of said group of pages, since each printer prints different types of print data differently (column 10, lines 19-26 of Rourke). Therefore, it would have been obvious to combine Rourke with Motoyama in view of Hanson to obtain the invention as specified in claims 47 and 59.

5. Claims 45 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Hanson (US Patent 5,956,736) and well-known prior art.

Further regarding claims 45 and 57: Hanson discloses that the PDMS receives the input identifiers through the GUI (figure 6C(610) and column 11, lines 27-30 of Hanson) by prompting the printer operator to select group identifiers from a list of

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identifiers (figure 6C(620) and column 11, lines 42-44 of Hanson).

Motoyama in view of Hanson does not disclose expressly that the printer operator is prompted to type the group identifiers into a dialog box.

Official Notice is given that entering text data into a dialog box is old, well-known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to type the group identifiers into a dialog box rather than select the group identifiers from a list; as specifically taught by Hanson. The suggestion for doing so would have been that typing text into a dialog box is one of the many types of data entry available to a computer user.

6. Claims 51 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Hanson (US Patent 5,956,736) and Kato (US Patent 5,978,557).

Regarding claims 51 and 63: Motoyama in view of Hanson does not disclose expressly replacing pages that do not have any identifiers with a media insertion command.

Kato discloses replacing a page that is not to be printed on a particular printer with a media insertion command (column 5, lines 39-42 of Kato).

Motoyama in view of Hanson is combinable with Kato because they are from the same field of endeavor, namely digital document processing and printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to output blank pages when there is no data for that page for the printer, as taught by Kato. The motivation for doing so would have been keep track of where the pages with no

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identifiers are when printing a document on multiple printers (column 5, lines 43-49 of Kato). Therefore, it would have been obvious to combine Kato with Motoyama in view of Hanson to obtain the invention as specified in claims 51 and 63.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A Thompson whose telephone number is 703-305-6329. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on 703-308-7452. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Thompson
Examiner
Art Unit 2624

JAT
04 February 2005



THOMAS D.
~~LEE~~
PRIMARY EXAMINER